

### ***REMARKS***

This is a full and timely response to the outstanding Office action mailed September 20, 2004. Upon entry of the amendments in this response, claims 1-20 are pending. More specifically, claims 1, 10, 17, and 19 are amended and claim 20 is added. These amendments are specifically described hereinafter. It is believed that the foregoing amendments add no new matter to the present application.

#### **I. Present Status of Patent Application**

Claims 17 and 19 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-2, 5-12 and 14-17 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Horvitz U.S. 6,161,130. Claims 3, 7, 13, 18 and 19 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Horvitz et al. U.S. 6,161,130. "Official Notice" is taken that the concept and advantages of employing an apparatus comprising a scrollable line display capable of presenting at least six lines by no more than fifteen lines is old and well known in the art. Claim 4 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Horvitz et al., U.S. 6,161,130 in view of Fuchigami U.S. 6,393,463.

#### **II. Examiner Interview**

Applicant first wishes to express his sincere appreciation for the time that Examiners Sall and Najjar spent with Applicant's Attorneys Jeffrey Kuester and Benjamin Balser during a November 4, 2004 telephone discussion regarding the above-identified Office Action. Applicant believes that certain important issues regarding amendments to the claims were identified during the telephone discussion, and that they are resolved herein. During that conversation, Examiner Sall seemed to indicate that it would be potentially beneficial for Applicant to file this amendment and response. Thus, Applicant respectfully requests that Examiner Sall carefully consider this amendment and response.

### **III. Miscellaneous Issues**

As to the Official Notice taken regarding claim 3, per MPEP 2144.03(A), "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." Applicants respectfully contend that employing an apparatus comprising a scrollable line display capable of presenting at least six lines but no more than fifteen lines has not been instantly and unquestionably demonstrated to be well-known. Even if the particular claim language taken separately were well-known, there is no factual basis for the legal conclusion that such claim language in combination with the other claim elements is well-known. Per MPEP 2144.03(B), "If such notice is taken, the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." As specific factual findings predicated on sound technical and scientific reasoning in support of the conclusion of common knowledge are not provided in the Office Action, the Official Notice is improper and should be withdrawn.

### **IV. Rejections Under 35 U.S.C. §102(e)**

#### **A. Claims 1-9 and 16**

The Office Action rejects claims 1-9 and 16 under 35 U.S. C. 102(e) as allegedly being anticipated by *Horvitz* (U.S. Patent No. 6,161,130). For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 1** recites:

1. A method of manipulating email messages with an email network appliance comprising:
  - receiving an email message, *the email message having had all attachments automatically deleted such that the email message is text only*;
  - classifying the text only email message;
  - inserting the text only email message into a classification container; and
  - presenting the classification container in a classification display section.

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 1 as amended is allowable for at least the reason that *Horvitz et al.* does not disclose, teach, or suggest at least **the email message having had all attachments automatically deleted such that the email message is text only**. Notwithstanding, no such teaching can be identified anywhere within this reference. Therefore, *Horvitz* does not anticipate claim 1, and the rejection should be withdrawn.

Because independent claim 1 as amended is allowable over the cited art of record, dependent claims 2-9 and 16 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-9 and 16 contain all the steps/features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 2-9 and 16 are patentable over *Horvitz*, the rejection to claims 2-9 and 16 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2-9 and 16 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 2-9 and 16 are allowable.

B. Claims 10-15, and 17-19

The Office Action rejects claims 10-15, and 17-19 under 35 U.S. C. 102(e) as allegedly being anticipated by *Horvitz* (U.S. Patent No. 6,161,130). For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 10** recites:

10. A system for presenting email messages comprising an email network appliance having:

a text only email message classifier;

a text only email message inserter for placing a text only email message within a classification container;

a display for presenting the classification container in an email network appliance; and

***a blinking light separate from the display to indicate an unread email.***

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 10 as amended is allowable for at least the reason that *Horvitz et al.* does not disclose, teach, or suggest at least a **blinking light separate from the display to indicate an unread email.**

Notwithstanding, no such teaching can be identified anywhere within this reference.

Therefore, *Horvitz et al.* does not anticipate claim 10, and the rejection should be withdrawn.

Because independent claim 10 as amended is allowable over the cited art of record, dependent claims 11-15 and 17-19 (which depend from independent claim 10) are allowable as a matter of law for at least the reason that dependent claims 11-15 and 17-19 contain all the steps/features of independent claim 10. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002); *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 11-15 and 17-19 are patentable over *Horvitz et al.*, the rejection to claims 11-15 and 17-19 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 10, dependent claims 11-15 and 17-19 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 11-15 and 17-19 are allowable.

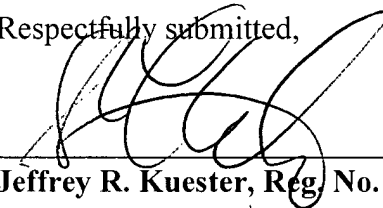
**V. Prior References Made of Record**

The prior references made of record have been considered, but are not believed to affect the patentability of the presently pending claims. Other statements not explicitly addressed herein are not admitted.

***CONCLUSION***

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-20 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



Jeffrey R. Kuester, Reg. No. 34,367

**THOMAS, KAYDEN,  
HORSTEMEYER & RISLEY, L.L.P.**  
Suite 1750  
100 Galleria Parkway N.W.  
Atlanta, Georgia 30339  
(770) 933-9500